

REMARKS/ARGUMENTS

The Office Action mailed December 8, 2003, and the references cited therein have been carefully reviewed in light of the Examiner's helpful comments and suggestions.

As a result of the Office Action, claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura in view of Lagoni. These references have been carefully reviewed but are not believed to show or suggest Applicant's invention as now claimed in any manner. Reconsideration and allowance of the pending claims is therefore respectfully requested in view of the following remarks.

By the above amendments, claims 5 and 6 have been cancelled without prejudice and claims 4 and 8 have been amended. Amended claim 4 now requires an incoming call-detection circuit disposed in the main unit and comprising, an alarm circuit for detecting the ringing of the incoming calls, a caller identification circuit for identifying the caller's phone number and an brief message, a transformation circuit for transforming messages into visual messages, and a control circuit operably connected to a volume adjustment of the main unit, wherein the incoming call-detection circuit is operably connected to a telephone line at one end and operably connected to the main unit at a second end, wherein the incoming-call detection circuit transforms messages of an incoming call into visual signals and outputs the visual signals.

Applicant respectfully submits that the combination set forth by the Examiner has been attained by use of impermissible hindsight based on the teachings of the present application. Prior to Applicant's invention, the problem of lowering the volume together

with displaying a caller's information on a television monitor while operating the sound system had not been addressed. Furthermore, the Examiner's statement regarding the combination of the references does not point to any motivational statements in any of the cited art. The Examiner has merely relied on a statement warned by the Federal Circuit in *In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir. 1998). The Court stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board did not, however, explain what specific understandings or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Instead, the Board merely invoked the high level of skill in the field of the art. If such a rote dictation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness, in the obviousness construct the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.


In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir. 1998).

The only logical way in which the Examiner may conceive the combination of the asserted references is by using Applicant's present teachings "as instruction manual or template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Therefore, in view of the foregoing, Applicant respectfully submits that the obviousness rejection be withdrawn.

Claims 7 is dependent from claim 4 and is therefore allowable for the same reasons as in claim 4. Method claim 8 has been amended in a similar manner as claim 4 and it is therefore believed to be allowable for the same reasons as claim 4.

Each issue raised in the Office Action mailed December 8, 2003, has been addressed and it is believed that claims 4, 7, and 8 are in condition for allowance. Wherefore, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
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